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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,556	08/24/2000	Jakob Scharf	194344US0	2549

22850 7590 06/19/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/19/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/644,556

Applicant(s)

SCHARF ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,2,11-26 and 28-67 is/are pending in the application.
- 4a) Of the above claim(s) 51,53-61 and 64-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,11-14,16,18,19,21-26,28-41,43,45-46,48-50,62,63 is/are rejected.
- 7) ☐ Claim(s) 15,17,20,42,44 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to the amendment filed March 14, 2003 in which claim 34 was amended.

The rejection of claim 34 under 35 U.S.C. 112, second paragraph is withdrawn in view of the amendment to the claim.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 2, 11-13, 22-24, 26, 28-40, 49-50, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halle (US 6,020,385) for the reasons of record.
3. Claims 1, 2, 11, 13, 14, 16, 18-19, 21, 24-26, 29-39, 41, 43, 45, 46, 48, 50 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 467850 for the reasons of record.

Applicant argues that neither Halle nor EP '850 disclose or suggest the claimed combination of inhibitors in a weight ratio of from 1:1 to 10:1 in a monomer composition. Applicant argues that while Halle teaches a large number of polymerization inhibitors, that there is no suggest to combine the two claimed inhibitors. Applicant argues that Halle exemplifies only one inhibitor in its monomer composition. Applicant argues that EP discloses a combination of two inhibitors and list additional inhibitors that include N-nitroso-N-phenylhydroxylamine. Applicant argues that EP contains no suggestion to combine the additional inhibitor with the preferred combination of two inhibitors of EP.

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Applicant argues that the data of the specification and the declaration submitted by Dr. Knebel show unexpected results.

Applicant's arguments have been considered but are not deemed to be persuasive. Halle teaches two inhibitors as does EP. It is well settled that it is prima facie obvious to combine two components, each of which is taught by the prior art to be useful for the same purpose, in order to form a composition to be used for the very same purpose. *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

Applicant's data and Dr. Knebel's declaration have been taken under consideration but are not deemed to constitute unexpected results.

The showings are not commensurate in scope with the claims. The showings are limited to hydroxyethyl methacrylate raw esters whereas the claims are limited to amides monomers (claim 1) or any ethylenically unsaturated monomer (claims 26 and 63). Applicant has not shown that the combination of inhibitors produce unexpected results when the monomer composition comprises amides or other monomers such as vinyl chloride or styrene or vinyl ether. Also, there are no proportions in the claims for the inhibitors. In the Examples of the declaration, Applicant uses 160-ppm diethylhydroxymine and 36 ppm of N-nitroso-N-phenylhydroxylamine ammonium salt (cupferron) per 1000 g monomer, and in the Examples of the specification 400-ppm diethylhydroxylamine and 50 ppm cupferron per 6 kg monomer are used for the monomer composition. Are unexpected results obtained with varying the amount of the inhibitors? Applicant has not shown this.

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Applicant points out that claims 51 and 58 are dependents of claim 1; claim 64 and 65 are dependents of claim 1 and claims 66 and 67 are dependents of claim 63.

Claims 51, 58, 64, 65, 66 and 67 are all processes involving 2-hydroxyalkyl (meth)acrylate. Claims 1, 11 and 63 are directed to stabilized monomer compositions. Claims 51, 58, 64, 65, 66 and 67 do not require the particulars of claims 1, 11 and 63, because the processes can be practiced without the use of a stabilized monomer composition. The process can be practiced with the inhibitors in the absence of the monomers.

4. Claims 15, 17, 20, 42, 44 and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach or suggest the inhibitors of the above claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

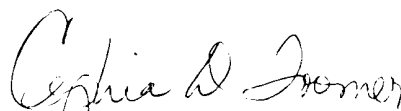
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Cephia D. Toomer
Primary Examiner
Art Unit 1714

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June 17, 2003